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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/131,744	08/10/1998	NORIBUMI KOITABASHI	884.2742	8265

5514 7590 12/12/2001

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30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/12/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/131,744

Applicant(s)

KOITABASHI ET AL.

Examiner

Michael E. Grendzynski

Art Unit

1774

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112 par 2.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-7 and 9/1.Claim(s) withdrawn from consideration: 8 and 9/2.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See Attached Notice of References Cited

Claim Rejections - 35 USC § 112

1. Examiner thanks applicants for pointed out that processing liquids are known in the art to be both chromatic and achromatic. This rejection is withdrawn.

Claim Rejections - 35 USC § 103

2. Claim 1 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Shioya, and claims 1-7 and 9/1 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shioya in view of Inui. Applicants argue that Shioya fails to disclose the claimed K_a or t_s values. With respect to the t_s value, Shioya discloses a t_s value as claimed by applicants. Specifically, Shioya discloses that the ink and the processing liquid are mixed together, either on the surface of or *at a position penetrating* the printing medium. *See* col 8, 1128-32. That is, the ink is placed on the medium, is left to penetrate the medium for a discernable time value, and then is printed with the processing liquid. With regard to the K_a values, these values are inherent in all liquids. These values, moreover, are known in the art to control such properties as feathering or bleeding. *See* Kimura (US 5955515) at col. 3, 1 40 through col. 4, 1 26 or Koike (US 5614931) at col. 1, 11 16-57 and col. 3, 1 10 through col. 4 1 38)¹. Though Shioya does not disclose a preferred K_a values, it is a known value one of ordinary skill in the art readily appreciates. It is a conventional concern; consequently, it would obvious to optimize the K_a values. The specification, moreover, does not appear to provide evidence that by maintaining the K_a values with the claimed ranges, a result-effective parameter results. Applicants are encouraged to provide evidence of result effectiveness--the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215. To date, this burden has not been sustained.

With regard to Inui, applicants argue that examiner has not provided requisite evidence showing why it would be desirable to use its heating step in the method of Shioya. It is the examiner's position that the requisite evidence has been provided. Inui, as already made of record, discloses that it is *known* in the art to provide the step

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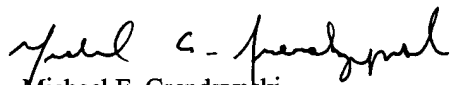
of heating the ink once it has been ejected on to a recording medium in order to control the penetration of the ink, and consequently, its bleeding. As such, it would be obvious to one of ordinary skill the art to heat any and all liquids where degree of penetration is a concern. Shioya, moreover, is concerned with the quality of the printed image—avoiding feathering and bleeding. See col 1, ll 54-67. Inui, as mentioned above, teaches it is known to accelerate the drying of the ink via heating, stating such a heating step “is effective for the preventing the bleeding of ink.” See col. 2, ll 29-31. One skilled in the art, then, would readily appreciate the step of heating a liquid used in an ink jet recording process—including the process disclosed by Shioya—to prevent the bleeding the liquid.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3599.


Michael E. Grendzynski
Assistant Examiner
November 28, 2001



BRUCE H. HESS
PRIMARY EXAMINER
GROUP 1300

¹ Both Kimura and Koike are cited as teaching references of an outstanding rejection, i.e., further explaining that Ka values are a conventional concern in the art. These are not cited as a new rejection or a new line of reasoning.